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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,622	05/11/2001	Hiromu Sugino	2001-0559A	6107

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WENDEROTH, LIND & PONACK, L.L.P.  
2033 K STREET N. W.  
SUITE 800  
WASHINGTON, DC 20006-1021

EXAMINER

ANDRES, JANET L

ART UNIT PAPER NUMBER

1646

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,622

Applicant(s)

SUGINO, HIROMU

Examiner

Janet L. Andres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 15, 16, 24 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6, 15, 24 and 31 is/are rejected.
- 7) ☒ Claim(s) 15, 24, 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/01, 10/03 6) ☐ Other: \_\_\_\_\_

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### **RESPONSE TO AMENDMENT**

1. Applicant's amendment filed 9 October 2003 is acknowledged. Claims 1-6, 15, 16, 24, and 31 are pending and under examination in this office action. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

#### ***Information Disclosure Statement***

2. Applicant states that the International Search Report submitted with the IDS indicates the degree of relevance of the Sugino reference. In response, the Sugino reference has been considered in full and the form 1449 initialed appropriately.

#### ***Claim Rejections/Objections Withdrawn***

3. The objection to the title as containing the word "novel" is withdrawn in response to Applicant's amendment changing the title.

4. The objection to claim 24 as depending from non-elected claims is withdrawn in response to Applicant's amendment changing the dependency of the claim.

5. The rejection of claims 1-6 under 35 U.S.C. 101 as being drawn to non-statutory subject matter is withdrawn in response to Applicant's amendment to the claims requiring that the proteins be isolated.

6. The rejection of claims 1-5 under 35 U.S.C. 102(b) as being anticipated by Hirao et al. is withdrawn in response to Applicant's amendment limiting these claims to SEQ ID NOs 5 and 6.

7. The rejection of claims 1-6, 15, 16, and 24 under 35 U.S.C. 112, second paragraph, as indefinite in the recitation of "substantially identical" is withdrawn in response to Applicant's amendment deleting this phrase.

***Claim Rejections Maintained/New Grounds of Rejection/Objection***

8. Claims 15, 16, and 24 are newly objected to for the use of the phrase “determining a protein”. While the method steps make it clear what is to occur, it is suggested that “identifying a protein” would serve to clarify the purpose of the method.

9. The rejection of claims 6, 15, 16, and 24 under 35 U.S.C. 102(b) as being anticipated by Hirao et al. is maintained for reasons of record in the office action of 11 June 2003 and newly applied to new claim 31.

These claims still encompass partial peptides. As was stated in the office action of 11 June 2003, Hirao et al. teaches a protein that is 98.5% identical to SEQ ID NO: 6, which is a fragment of SEQ ID NO: 5. Portions corresponding to various domains are taught by Hirao et al.; see figure 2. The portion taught by Hirao et al. as the second WW domain is identical to a portion of instant SEQ ID NOS: 5 and 6. The second PDZ domain is identical to a portion of instant SEQ ID NOS: 5 and 6. The fifth PDZ domain is also identical to a portion of instant SEQ ID NOS: 5 and 6. See sequence listing attached to the previously provided Hirao document. Thus Hirao et al. anticipates claims to peptide portions of SEQ ID NOS: 5 and 6. As stated in the previous office action, methods using the two-hybrid system and using co-precipitation are taught on pp. 21107-21109. The use of the different PDZ domains, including the two that are identical to portions of SEQ ID NO: 5 and 6, is taught in table 1, p. 21108, column 1. Thus Hirao et al. anticipates claims 15 and 16. Since these portions were expressed, they were inherently in a diluent, thus anticipating new claim 31. Thus Hirao et al. anticipates claims drawn to portions or methods using them.

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Applicant argues with respect to claim 1 that the ARIP1 protein lacks the GK domain in the N-terminus of S-SCAM and has no ability to bind SAPAP. As it applies to claim 6, this argument is not persuasive because claim 6 recites portions of SEQ ID NO: 5 and 6, and, as stated above, the Hirao document teaches portions of S-SCAM that are identical to portions of the instant sequences.

**CLAIMS 1-5 ARE ALLOWED. CLAIMS 6, 15, 16, 24, AND 31 ARE REJECTED.**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

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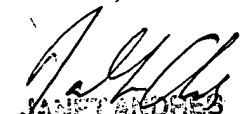
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.  
December 29, 2003

  
JANET ANDRES  
PATENT EXAMINER